



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 09/922,076 | 08/02/2001 | Takahisa Kageyama | 393032027500 | 8741 |
| 25224 | 7590 | 12/29/2005 | EXAMINER | |
| MORRISON & FOERSTER, LLP | | | NGUYEN, MINH DIEU T | |
| 555 WEST FIFTH STREET | | | | |
| SUITE 3500 | | | ART UNIT | PAPER NUMBER |
| LOS ANGELES, CA 90013-1024 | | | 2137 | |

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/922,076 | KAGEYAMA ET AL. | |
| | Examiner | Art Unit | |
| | Minh Dieu Nguyen | 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the communication dated October 17, 2005 with the amendments to claims 1, 5-6 and 10-12.

Claims 1-12 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments focus on the combination of features introduced by the amendment with elements that already existed in the claims. The new material is rendered obvious by Kato (5,953,529).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino (6,433,946) in view of Kato (5,953,529).
 - a) As to claims 1 and 11-12, Ogino discloses a method, device and recording medium for output control and copying prevention control comprising a notification

Art Unit: 2137

section (Fig. 8, element 18; col. 13, lines 49-56) that notifies a user of a message calling the user's attention to the presence of copyright protection for digital data subject to the specific process in response to an instruction issued on the specific process; a function-setting section that sets a specific function (i.e. anti-duplication control information indicating copying inhibition, copying permission or generation restriction, col. 2, lines 31-33, the anti-duplication control information is added to the video signal and recorded on the recording medium to prevent illegal copying) for removing restriction on the execution of the specific process when the user indicates an acceptance to the contents of the message.

Ogino discloses the write control signal permits writing the video signal on the recording medium (col. 17, lines 5-12; col. 20, lines 43-47) when determination is made by duplication controller whether duplication is to be inhibited or permitted, i.e. Ogino implicitly discloses an execution restriction-removal section that removes restriction on the execution of the specific process based on the set specific function.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of removing the restriction on the execution of the specific process in the system of Ogino so as to make the user interactions with the system more friendly.

Ogino does not expressly disclose an inhibiting section that inhibits the notification section from notifying the user of the message once upon the user's acceptance to the contents of the message.

Kato discloses stopping the issue of the warning message once upon the user confirms the execution of the forced writing (col. 18, lines 1-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of stopping the issue of the warning message once upon the user confirms the execution of the forced writing in the system of Ogino, as Kato discloses so as to prevent redundant message and make the system more user friendly.

b) As to claims 3-4 and 10, Ogino discloses a data storage device that stores the digital data and wherein the specific process includes storing digital audio data or image data taken in from an outside of the electronic apparatus in the data storage device (Fig. 1).

c) As to claims 5-6, Ogino discloses the notification section notifies the user of the message in dependence on whether unauthorized duplication of digital data on which the specific process is to be carried out is inhibited (col. 14, lines 43-47; col. 20, lines 16-23).

d) As to claims 7-8, Ogino discloses the notification section displays a message concerning a copyright on a screen or notifies the message by voice in response to an instruction for executing the specific process or an instruction for setting the specific function (col. 15, lines 6-10).

5. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino (6,433,946) in view of Matsumoto (6,542,870).

Matsumoto discloses a recording apparatus capable of recording and storing data from a storage medium comprising a setting information storage device that stores information indicative of the setting of the set specific function and a recording section that stores the information in the setting information storage device (Fig. 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of storing information indicative of the setting of the set specific function in a storage device as Matsumoto teaches in the system of Ogino to provides a means to store and retrieve information as needed.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Minh Dieu Nguyen
Examiner
Art Unit 2137

mm
mdn
12/23/05

E. Moise
EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER